



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/630,345	07/31/2000	Anand C. Burman	U 012858-1	5580

140 7590 03/31/2004

LADAS & PARRY
26 WEST 61ST STREET
NEW YORK, NY 10023

EXAMINER

MOHAMED, ABDEL A

ART UNIT	PAPER NUMBER
----------	--------------

1653

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/630,345

Applicant(s)

BURMAN ET AL.

Examiner

Abdel A. Mohamed

Art Unit

1653

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 February 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 23 February 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 28-46.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet


CHRISTOPHER S. F. LOW
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Continuation of 10. Other: It is noted that Applicant has canceled claims 1-9 and 14-27 and submitted new claims 28-46. Newly presented claim 28 has been amended by changing the preamble of canceled claim 1 from "A peptide derivative of the formula" to --A peptide of the sequence-- and deleting the sequence identifier number (i.e., SEQ ID NO:7) and incorporating the limitations of canceled claims 1 and 2 into newly presented claim 28. The rejection of newly submitted claims 28-46 under the judicially created doctrine of double patenting over claims 1-33 of U.S. Patent No. 6,492,330 and the provisional rejection under the judicially created doctrine of obviousness-type double patenting over claims 1, 3, 4 and 32-36 of copending application serial number 09/248,382 are maintained for the reasons of record. The Examiner has indicated that if the amino acids are from the same source, have the same sequences and are used for the same purposes; the use of different protecting groups would not make the application patentable over each other. Because it would have been obvious for the reasons of record to use or adapt the claimed protecting groups (namely, alkanoyl, or Deg such as alpha, alpha dialkylated amino acid or a D-amino acid or any protecting groups) for the intended purposes of making peptides (amino acid sequences) more stable and resistant, for example, to enzymatic degradation (See e.g., page 5 of Paper No. 17 of copending application Serial No. 09/248,382). Thus, it is conventional and known in the art to modify the peptides as claimed in copending application and '330 patent (i.e., substitution of D amino acid for L amino acid in a peptide sequence) for treating cancer. Therefore, in view of what is known in the art as discussed in Paper No. 17 of copending application Serial No. 09/248,382, it is an obvious variation to one of ordinary skill in the art to replace sequences claimed in copending application and '330 patent by Deg at least in one of the amino acid position 1-8 while the sequence recited in claim 28 of the instant application the "X" could be replaced by any alkanoyl groups recited in claim 2 or by alpha, alpha dialkylated amino acid e.g. Aib or Deg or by any other protecting groups or can contain a D-amino acid. Absent of filing a terminal disclaimer (TD) or showing that the protecting groups claimed would result in different advantages or unexpected results (i.e., would have different advantages or unexpected effects on the peptides claimed than the peptides of copending application Serial No. 09/248,382 and '330 patent), the rejections under obviousness-type double patenting are maintained for the reasons of record.

DUPLICATE CLAIMS, WARNING

Applicant is advised that should claim 44 be found allowable, claim 45 will be objected to under 37 CFR 1.75 as being a word for word duplicate. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).